

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 2/5/98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re ERA Productions USA Corp.

Serial No. 74/530,175

Alan U. Schwartz, Geoffrey A. Berkin, and Jill M. Pietrini
of Manatt, Phelps & Phillips for applicant.

Cindy B. Greenbaum, Trademark Examining Attorney, Law Office
104 (Sidney Moskowitz, Managing Attorney).

Before Rice, Hanak, and Hohein, Administrative Trademark
Judges.

Opinion by Rice, Administrative Trademark Judge:

An application has been filed by ERA Productions USA
Corp. to register the mark ERA INTERNATIONAL LTD
(INTERNATIONAL LTD disclaimed) for production and
distribution of motion picture films and production of
videotapes.¹

Registration has been finally refused under Section
2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), on

¹ Application Serial No. 74/530,175 filed May 27, 1994, claiming
first use and first use in commerce on March 31, 1984.

the ground that applicant's mark, as used in connection with its services, so resembles two registered marks as to be likely to cause confusion, or to cause mistake, or to deceive. The cited registrations, both of which are owned by K-Tel International, Inc., are for the marks ERA for phonograph records, pre-recorded audio tapes and compact discs featuring music and various entertainment themes,² and the mark E ERA and design, as shown below (in reduced size),

for phonograph records, pre-recorded audio tapes and compact discs featuring music.³

² Registration No. 1,568,087 issued November 28, 1989, affidavit Sec. 8 accepted, affidavit Sec. 15 received.

³ Registration No. 1,618,560 issued October 23, 1990, affidavit Sec. 8 accepted, affidavit Sec. 15 received.

The Examining Attorney initially cited a third registration owned by the same registrant, namely, Registration No. 1,824,227 issued March 1, 1994 for the mark ERA RECORDS and design (RECORDS disclaimed) for prerecorded phonograph records, audio tapes and compact discs featuring music. This registration was inadvertently omitted from the final refusal to register. The omission is immaterial, however, because the mark in cited Registration No. 1,568,087 is, in any event, more similar to applicant's mark than is the mark in the omitted registration.

Finally, the Examining Attorney cited a registration owned by a different registrant, Electronic Realty Associates, Inc., namely, Registration No. 1,196,711 issued June 1, 1982 for the mark ERA and design (with color linings for the colors red and blue), as shown below (in reduced size),

In support of the refusal to register, the Examining Attorney has made of record copies of more than 40 applications and registrations wherein 28 parties have applied to register, or have registered, their marks for at least one of the services listed in applicant's application and, at the same time, at least one of the goods listed in the cited registrations.⁴ These application/registration copies, said by the Examining Attorney to be a representative sample, were offered by the Examining Attorney to show that services and goods of the types listed in applicant's application and registrant's registrations may emanate from the same source. The 28 applicants and/or registrants include companies such as Metro-Goldwyn-Mayer, Inc., Columbia Pictures Industries, Inc., TriStar Pictures, Inc., and Paramount Pictures Corporation.

Applicant, in turn, has submitted the results of a search of Thomson & Thomson's TRADEMARKSCAN computerized file of federal registrations, offered to show that there are 3751 registrations for musical sound recordings and/or

for tapes, cassettes, filmstrips, motion picture film, calculators, film projection and viewing apparatus, telecopiers, and luminous signs. This registration was withdrawn as a reference against applicant's mark after applicant submitted arguments concerning the differences between its services and this registrant's goods, as well as the differences in the marks used in connection therewith.

⁴ Some of the parties have more than one application or registration included in the copies made of record by the Examining Attorney.

pre-recorded audio tapes, compact discs, and phonograph records, and 1476 registrations for the production and distribution of motion picture films and videotapes. According to applicant, this evidence, viewed together with the Examining Attorney's evidence, shows that "it is rare, not common, for a manufacturer of pre-recorded audio tapes, compact discs, and phonograph records to also produce and distribute motion picture films and video tapes, and vice versa."⁵

We turn first to a comparison of applicant's mark ERA INTERNATIONAL LTD with registrant's mark ERA, the most pertinent of the cited marks. It is true, as applicant argues, that in determining likelihood of confusion, marks must be considered in their entirety, including any

⁵ Attached to applicant's brief on the case is an electronic printout of an article from the July 25, 1995 issue of The Hollywood Reporter. The article concerns registrant K-Tel International and its marketing methods and trade channels. The Examining Attorney's objection to this article on the ground of untimeliness is well taken, and the article has not been considered in our determination of this case. See Trademark Rule 2.142(d), 37 CFR §2.142(d). Moreover, there are no limitations in the identifications of goods in the cited registrations as to marketing methods, channels of trade, or classes of customers, and it is these identifications which are controlling on the issue of likelihood of confusion herein, regardless of what the evidence of record may show as to registrant's actual marketing methods, trade channels, and classes of purchasers. Thus, we must presume, for purposes of determining the issue of likelihood of confusion herein, that registrant's goods are sold through all of the usual marketing methods and trade channels to all of the normal classes of purchasers for goods of the specified type. See, for example, *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992), and *In re Bercut-Vandervoort & Co.*, 229 USPQ 763 (TTAB 1986). Cf. *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990), and *Canadian*

disclaimed matter, because that is the way they are encountered in the marketplace. Nevertheless, when comparing marks in their entirety, one feature of a mark may be more significant than another, hence greater weight may be given to that feature. See *Giant Food, Inc. v. Nation's Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 198 (Fed. Cir. 1983), and *In re National Data Corp.*, 735 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). As the Court stated in the latter case, at page 751:

The basic principle in determining confusion between marks is that marks must be compared in their entirety and must be considered in connection with the particular goods or services for which they are used. [citations omitted] It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark, that is, only part of a mark. On the other hand, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety. Indeed, this type of analysis appears to be unavoidable.

In the present case, the Examining Attorney has quite properly accorded more weight to the term ERA in applicant's mark than to the words INTERNATIONAL LTD. The term ERA is the first word of applicant's mark and is arbitrary as applied to the services and goods involved in this case, insofar as the record herein shows. The subsequent words

Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

INTERNATIONAL LTD, on the other hand, are descriptive in nature and without any great trademark significance.

Moreover, we note that the drawing of applicant's mark is in typed capital letters, pursuant to Trademark Rule 2.51(e). This means that applicant's application is not limited to the mark depicted in any special form; that the Board, in determining likelihood of confusion, must consider all reasonable manners in which the mark might be used; and that in trying to visualize other manners, the Board may look to the specimens of record, which illustrate the manner in which the mark has actually been used. See *Phillips Petroleum Co. v. C. J. Webb, Inc.*, 442 F.2d 1376, 170 USPQ 35 (CCPA 1971); *Jockey International Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233 (TTAB 1992); *In re Fisher Tool Co., Inc.*, 224 USPQ 796 (TTAB 1984); and *Quaker Oats Co. v. General Foods Corp.*, 181 USPQ 668 (TTAB 1974). The specimens submitted by applicant in this case show use of the mark ERA INTERNATIONAL LTD in the following manner (the mark is reproduced below in actual, not reduced, size):

There can be no doubt that it is the term ERA which visually dominates the commercial impression created by applicant's mark in actual use, and that it is this term which is the

most significant portion of the mark. Indeed, the words INTERNATIONAL LTD are nearly illegible as used in the specimens of record.

Comparing applicant's mark ERA INTERNATIONAL LTD, considered in its entirety, with registrant's mark ERA, we conclude that they create very similar commercial impressions.⁶

Turning to a consideration of the goods (phonograph records, pre-recorded audio tapes and compact discs featuring music and various entertainment themes) and services (production and distribution of motion picture films and production of videotapes) involved in this case, they obviously are not the same. However, goods and/or services need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Rather, it is sufficient for the purpose that the goods and/or services are related in some manner, or that they are marketed under such conditions that they would likely be encountered by the same persons under circumstances that could give rise, in view of the marks used thereon, to the mistaken belief that they originate from the same source. *See Kraft, Inc. v. Country Club Food Industries, Inc.*, 230

⁶ We find totally unpersuasive applicant's argument that the term ERA in registrant's marks would be perceived as having a different meaning than the same term in applicant's mark.

USPQ 549 (TTAB 1986); *Mobay Chemical Co. v. Standard Oil Co.*, 163 USPQ 230 (TTAB 1969); and cases cited therein.

In the present case, the third-party applications and registrations made of record by the Examining Attorney indicate that goods and services of the specified types may emanate from the same source under the same mark. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); *In re Perez*, 21 USPQ2d 1075 (TTAB 1991); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988). Applicant's argument that its own third-party registration evidence shows that it is rare, not common, for these goods and services to emanate from the same source is not convincing. The fact that a registration has only the goods (or only the services) does not necessarily mean that the registrant does not also produce and market the services (or the goods). Rather, it only establishes that registrant may not have registered its mark, at least in the same registration, for both the goods and services. We use the words "may not have" rather than "has not" because the Examining Attorney has stated that the applications and registrations which she made of record constitute a representative sample, that is, they are not inclusive.⁷ Here, the evidence submitted by

⁷ Thus, we do not know, from the evidence of record, exactly how many registrations and applications there are with both the involved goods and the involved services. Moreover, it was not incumbent upon the Examining Attorney to make all such registrations and applications of record. Rather, where the

the Examining Attorney shows that a substantial number of entities have registered, or applied to register, their marks for both goods and services of the types involved in this case. This factor is an indication of relatedness.

Applicant contends, however, that the only common factor regarding the goods and services is that they are both entertainment related; that being in a broad field such as the entertainment industry does not necessarily mean that the goods and services are related, or are sold to the same customers through the same channels of trade; that applicant offers its motion picture and videotape production and distribution services to executives in the motion picture industry who produce or license motion pictures; that applicant does not offer its services to the general public, nor does applicant sell them via television or direct mail solicitation; that registrant offers its goods to the general public via cable television and direct mail solicitation, and is not known for sales through retail stores;⁸ that applicant's services and registrant's goods

number of such registrations and applications is high, the Examining Attorney may make of record a representative sample thereof, indicating that it is a representative sample, and including enough of the registrations and applications to be persuasive.

⁸ As noted above, in footnote 5, applicant's arguments as to registrant's particular trade channels and marketing methods are of no avail, because registrant's identification is unlimited as to these matters. We must therefore presume, for example, that registrant's trade channels include retail stores, which are a normal trade channel for goods of the type listed in registrant's identification.

are thus sold through different channels of trade; that the only customers who will encounter both applicant's services and registrant's goods are applicant's customers, who are sophisticated, purchase applicant's services only after several months of negotiations, and know well with whom they are dealing at the time a purchase is made; and that despite the fact that applicant and registrant have been using their respective marks contemporaneously for eight years, applicant is unaware of any instances of actual confusion.

The Examining Attorney, on the other hand, argues that the specimens submitted by applicant show use of applicant's mark on a videotape for home use; that thus, although applicant may offer its services to executives in the movie industry and not to the general public, the general public clearly is exposed to the end product of applicant's services, namely, the videotapes and movies that applicant produces and distributes; that members of the general public may attend applicant's movies or rent or purchase applicant's videotapes and be exposed to applicant's mark, and may also purchase the movie soundtrack and be exposed to registrant's mark; and that such exposure would likely result in confusion as to source based on the similarity of the marks and the highly related nature of the goods and services.

We find applicant's arguments persuasive on the issue of likelihood of confusion insofar as customers for its identified services are concerned, because these services are of such nature that they are purchased with care by sophisticated purchasers. However, we agree with the Examining Attorney that customers for registrant's identified goods, namely, members of the general public, may encounter not only registrant's mark but also applicant's mark, albeit not as purchasers for applicant's services, and that these persons are likely to be confused as to source in view of the similarity between the marks and the relationship between applicant's services and registrant's goods (which relationship, contrary to applicant's arguments, goes far beyond the fact that both are entertainment related). See, in this regard, J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 23.7 (4th ed. 1996), and cases cited therein.

Moreover, the fact that applicant is unaware of any instances of actual confusion despite eight years of contemporaneous use is neither surprising nor controlling in this case. As applicant itself has emphasized, its services are purchased with care by sophisticated customers who know well with whom they are dealing and are not likely to be confused by the contemporaneous use by applicant and registrant of their marks in connection with their involved

activities. Because applicant's sales are to purchasers of this type, applicant is not likely to hear about instances of actual confusion among members of the general public who are customers for registrant's goods but not for applicant's services, i.e., the very persons who are likely to be confused in this case.

For the foregoing reasons, we agree with the Examining Attorney that applicant's mark ERA INTERNATIONAL LTD, as used in connection with its services, so resembles registrant's mark ERA (Registration No. 1,568,087) as to be likely to cause confusion, or to cause mistake, or to deceive.

The issue of likelihood of confusion presented by the other cited registration, namely, Registration No. 1,618,560 for the mark ERA and design, presents a closer question because of the design features in that registered mark. Nevertheless, the term ERA is a very prominent part of that mark, and we conclude that customers for registrant's goods who are familiar with its use of various marks composed of or prominently featuring the term ERA are likely to believe, upon encountering applicant's mark ERA INTERNATIONAL LTD, that this is yet another "ERA mark" used by the same source to designate a somewhat differing but related activity. We therefore find that the refusal to register on the basis of this registration is also well taken.

Ser. No. 74/530,175

Decision: The refusal to register is affirmed.

J. E. Rice

E. W. Hanak

G. D. Hohein
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

Ser. No. 74/530,175

J. E. Rice

K. E. W. Hanak

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